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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,000	07/22/2003	Gary William Flake	600189-148	8179
76041	7590	02/12/2008		
YAHOO! INC. C/O DREIER LLP 499 PARK AVENUE NEW YORK, NY 10022			EXAMINER KARDOS, NEIL R	
			ART UNIT 3623	PAPER NUMBER
			MAIL DATE 02/12/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/625,000

Applicant(s)

FLAKE ET AL.

Examiner

Neil R. Kardos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This is a final Office action on the merits.
Claims 1, 12, and 13 have been amended.
Currently, claims 1-14 are pending and have been examined.

Response to Arguments

2. Applicant's arguments with respect to claims 11, 12, and 14 are sufficient to overcome the 35 U.S.C. §112 rejections set forth in paragraph(s) 3 of the previous office action.

Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

Response to Amendment

3. Applicant's amendment to claim 12 is sufficient to overcome the objections set forth in paragraph(s) 2 of the previous office action.

Applicant's filing of a terminal disclaimer on 10/29/2007 is sufficient to overcome the nonstatutory double patenting rejection set forth in the previous office action.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 1-10 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. pre-grant publication number 2003/0105677 to Skinner et al (“Skinner”).

As per claim 1, Skinner discloses in a computerized system for allowing transactions in instruments, the instruments being capable of being valued based on values of term-based concepts, and terms of the concepts being useable in computerized searches, a method for valuing a concept comprising a set of one or more terms, the method comprising:

- obtaining quantitative data associated with at least one of the concept and one or more of the terms of the term set (see paragraph 38 and paragraph 12: lines 1-9, disclosing tracking search terms to determine effectiveness based on a number of impressions, number of clicks, and number of sales);
- operating on the data to produce a quantitative statistic (see id., disclosing, inter alia, analyzing the data as well as collecting it); and
- determining a value of the concept based at least in part on the produced statistic such that the value is used in the computerized system allowing transactions in the instruments (see id., disclosing determining the search terms effectiveness to advertising and marketing; paragraphs 12 and 37, disclosing using the value in a computer).

As per claim 2, Skinner discloses obtaining quantitative data associated with at least one of demand for the concept and demand for one or more of the terms of the term set (see paragraphs 12 and 37-38, disclosing obtaining demand based on impressions, clicks, and sales; paragraph 48, disclosing obtaining competitor demand information).

As per claim 3, Skinner discloses obtaining quantitative data associated with at least one of demand for the concept for use in advertising and demand for one or more of the terms of the term set for use in advertising (see paragraphs 12 and 38, disclosing obtaining data related to advertising and marketing).

As per claim 4, Skinner discloses measuring the demand for use in advertising based on one or more amounts paid for use in advertising (see paragraph 48, disclosing obtaining competitor bid information).

As per claim 5, Skinner discloses measuring the demand for use in advertising based on one or more amounts paid for use in advertising, wherein the use in advertising comprises obtaining one or more rights to have an advertisement included in results from one or more computerized searches using at least one of the terms of the term set (see *id.*).

As per claim 6, Skinner discloses operating on the data by using the data in at least one mathematical formula (see paragraphs 44-45; paragraphs 50-60).

As per claim 7, Skinner discloses collecting quantitative data relating to one or more Pay-Per-Click auctions (see paragraphs 5, 8, 20, and 39).

As per claim 8, Skinner discloses operating on the data by using at least one of a total revenue per period calculation, a median revenue per period calculation, an average revenue per period calculation, an average of median bid price calculation, and a median of median clicked price calculation, and a median click calculation (see paragraph 38, disclosing determining impressions, clicks, and sales per period; paragraph 41: lines 4-10, disclosing recording the amount of purchase; paragraph 44: lines 11-15, disclosing calculations with the amount of sales; paragraph 53, disclosing profits).

As per claim 9, Skinner discloses taking at least one measure to prevent intentional manipulation of the value of the concept (see paragraph 44, disclosing requiring a minimum threshold of actions to ensure accurate data; paragraph 37: lines 11-12, disclosing removing duplicate data).

As per claim 10, Skinner discloses taking at least one measure to maintain liquidity (see paragraphs 16 and 21, disclosing eliminating bid gaps and preventing overbidding, which serve to maintain liquidity in an advertiser's account).

As per claim 13, Skinner discloses in a computerized system for allowing transactions in instruments, the instruments being capable of being valued based on values of term-based concepts, and terms of the concepts being useable in computerized searches, a method for valuing a concept comprising a set of one or more terms, the method comprising:

- obtaining quantitative data associated with at least one of demand for the concept and demand for one or more of the terms of the term set (see paragraph 38 and paragraph 12: lines 1-9, disclosing tracking search terms to determine effectiveness based on a number of impressions, number of clicks, and number of sales);
- operating on the data to produce a quantitative statistic (see id., disclosing, inter alia, analyzing the data as well as collecting it); and
- determining a value of the concept based at least in part on the produced statistic (see id., disclosing determining the search terms effectiveness to advertising and marketing; paragraphs 12 and 37, disclosing using the value in a computer),

- comprising taking at least one measure to prevent intentional manipulation of the value of the concept (see paragraph 44, disclosing requiring a minimum threshold of actions to ensure accurate data; paragraph 37: lines 11-12, disclosing removing duplicate data).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 11-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skinner in view of Official Notice.

As per claim 11, Skinner does not explicitly disclose operating on the data by using a median click calculation, and comprising omitting from the median click calculation one or more highest and lowest price quantities.

However, Skinner teaches determining a number of clicks per time period (see paragraph 38) and using that to determine a reasonable estimate of the expected clicks for a future time period (see paragraph 43: lines 10-11).

Examiner takes Official Notice that it is well known in the statistical arts to average a set of data, including using a median value, over past time periods in order to determine an expectation for future time periods. Furthermore, Examiner takes Official Notice that it is well

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known in the statistical arts to omit outliers of highest and lowest values from a median calculation.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use well-known statistical methods in conjunction with the click data disclosed by Skinner. One of ordinary skill in the art would have been motivated to do so for the benefit of a more accurate prediction.

As per claim 12, Skinner does not explicitly disclose omitting from the median click calculation the same number of highest price quantities as lowest price quantities.

Examiner takes Official Notice that it is well known in the statistical arts to eliminate an equal number of outliers from a median calculation.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use well-known statistical methods in conjunction with the click data disclosed by Skinner. One of ordinary skill in the art would have been motivated to do so for the benefit of a more accurate prediction.

As per claim 14, Skinner does not explicitly disclose using a median click calculation in determining the statistic, and comprising omitting from the median click calculation one or more highest and lowest price quantities.

However, Skinner teaches determining a number of clicks per time period (see paragraph 38) and using that to determine a reasonable estimate of the expected clicks for a future time period (see paragraph 43: lines 10-11).

Examiner takes Official Notice that it is well known in the statistical arts to average a set of data, including using a median value, over past time periods in order to determine an

expectation for future time periods. Furthermore, Examiner takes Official Notice that it is well known in the statistical arts to omit outliers of highest and lowest values from a median calculation.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use well-known statistical methods in conjunction with the click data disclosed by Skinner. One of ordinary skill in the art would have been motivated to do so for the benefit of a more accurate prediction.

Additional Prior Art

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Pre-grant publication number 2004/0148222 to Sabella et al, directed to a method and system for online advertising.

Pre-grant publication number 2004/0167845 to Corn et al, directed to determining a minimum price per click for a term in an internet auction.

U.S. patent number 6,269,361 to Davis et al, directed to influencing a position on a search result list generated by a computer network.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil R. Kardos whose telephone number is (571) 270-3443. The examiner can normally be reached on Monday through Friday from 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Neil R. Kardos
Examiner
Art Unit 3623

NRK
2/7/08

/Beth Van Doren/
Primary Examiner, Art Unit 3623